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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/718,852
Filing Date: November 20, 2003
Appellant(s): HIXON ET AL.

MAILED
JAN 10 2008
GROUP 3700

Brick G. Power
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 22, 2006 appealing from the
Office action mailed October 17, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application Number: 09/864,723

Appeal Number: 20073074

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 48 and 61-77.

Appellant's statement regarding the withdrawn claims 1-47 and 49-60 is not an appealable matter. Furthermore, the election was made without traverse.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3,469,488	GASPARI	9-1969
4,537,588	EHLSCHEID ET AL	8-1985
5,172,622	SABIN	12-1992

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 64-68 and 70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 64, is “a support” in addition to “support” recited in claim 63?

In claims 65 and 70, “said surface of said substantially planar plate” lacks positive antecedent basis.

In claim 68, “said distance” and “said surface of said substantially planar plate” lack positive antecedent basis.

Claims 48, 61-62, 68, 75, and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Gaspari (US 3,469,488).

Gaspari discloses all the recited elements of the invention including a portable, substantially rigid, substantially planar plate (11) including a back side (at 12) and at least one cutting edge (14, 14a) protruding from a front side/surface of the substantially planar plate. Regarding claim 68, col. 4, lines 17-22.

Claims 48, 61-67, and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Sabin (US 5,172,622).

Sabin discloses all the recited elements of the invention including a portable, substantially rigid, substantially planar plate including a back side (30) and at least one cutting edge (32) protruding from a front side/surface of the substantially planar plate. Regarding claim 63, a substantially rigid support (22). Regarding claim 64, as best understood, the support formed from a material softer than the material of the cutting edge (col. 4, lines 38-41). Regarding claims 65-67, as best understood, at least one ejection element comprising at least one compressible, resilient member (33, Figure 5).

Claims 48, 61-62, 68-70, and 75-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Ehlscheid et al. (US 4,537,588).

Ehlscheid discloses all the recited elements of the invention including a portable, substantially rigid, substantially planar plate including a back side (1) and at least one cutting edge (1a) protruding from a front side/surface of the substantially planar plate. It is noted that the plate can be configured to be secured to a portable die cutting apparatus. Regarding claims 68-69, col. 3, line 27 (0.2 mm is about 0.01 inch). Regarding claim 70, col. 3, line 32. Regarding claim 75, the plate has dimensions for compact and portable storage. Regarding claim 76, col. 1, lines 44-47.

Claims 71-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaspari or Ehlscheid.

Gaspari or Ehlscheid discloses the invention substantially as claimed except for peripheral dimensions of the plate of about 2 inches by about 2 inches. One

having ordinary skill in the art would have been motivated to make the plate having different peripheral dimensions (e.g., 2" x 2") in order to accommodate sizes of indicia desired or sizes and shapes of cutouts desired. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

(10) Response to Argument

The rejections of claims 64-68 and 70 under 35 U.S.C. 112, second paragraph

Regarding claim 64, appellants contend that the language of claim 64 is clear in that "a support" in claim 64 is not necessarily the same as "a substantially rigid support" set forth in claim 63. Furthermore, regarding claims 65 and 70, appellants argue that it is evident that "said surface" is referring to the front side set forth in claim 62.

The examiner respectfully disagrees. There is no support in the specification for two supports that are configured to receive the cutting edge at the same time. For example, Figure 3B shows two elements attached together to form a sheet support surface; however, the cutting edge is forced against only to the top element (see figure below). In addition, claims do not refer "said surface" to the front side.

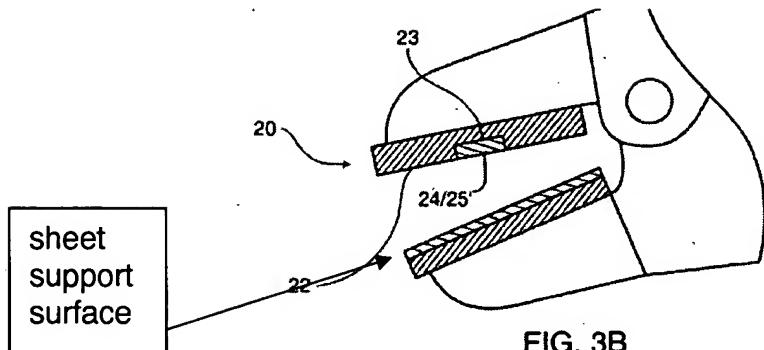


FIG. 3B

The rejections of claims 48, 61-62, 68, 75, and 77 under 35 U.S.C. 102(b) as being anticipated by Gaspari.

Appellants contend that Gaspari does not teach a "substantially planar" plate and "a back side configured to be supported by a substantially planar die supporting surface of a portable press". In addition, appellants argue that Gaspari does not teach the distance of the cutting edge protruding from a surface is greater than a thickness of the substantially planar plate.

The examiner respectfully disagrees. The term "planar" is defined as "Of or relating to a plane; (having parts) situated in or forming a plane or (esp. parallel) planes; flat, two-dimensional" Oxford English Dictionary (definition adj. 1.). However, appellant's die includes a plate with a thickness and a planar surface. Hence, appellant's die is not two-dimensional. The die of Gaspari is relatively flat and contains a planar surface as is in appellant's die. It is noted that the term "planar" is not specifically defined to preclude a plate having different thickness than the preferred embodiment set forth in the appellant's written description. Furthermore, Gaspari does teach a die having a back side capable of being supported by a substantially planar die supporting surface of a portable press. Moreover, the examiner does not understand

appellant's argument regarding the protruding distance. Gaspari teaches that a thickness of the substantially planar plate is 0.17 inch which is greater than a distance the cutting edge protrudes from a surface of the plate which is 0.08 inch.

The rejections of claims 48, 61-67, and 77 under 35 U.S.C. 102(b) as being anticipated by Sabin.

Appellants contend that Sabin does not teach a "substantially planar" plate and does not disclose the die used with a portable press.

The examiner respectfully disagrees. As set forth above, appellant's die is not two-dimensional. The die of Sabin is relatively flat and contains a planar surface as is in appellant's die. Furthermore, Sabin does teach a die having a back side capable of being supported by a substantially planar die supporting surface of a portable press.

The rejections of claims 48, 61-62, 68-70, and 75-76 under 35 U.S.C. 102(b) as being anticipated by Ehlscheid et al.

Appellants contend that Ehlscheid fails to teach a substantially rigid, substantially planar plate. Appellants further contend that Ehlscheid fails to teach a back side that is configured to be concurrently and completely supported by a substantially planar surface as pressure is simultaneously applied to the cutting edge. Furthermore, appellants argue that Ehlscheid does not expressly or inherently describe the die having dimensions that facilitate compact and portable storage.

The examiner respectfully disagrees. The phrases "substantially rigid" and "substantially planar" are not specifically defined to preclude a plate having different thickness to provide a planar surface and the rigidity than the preferred embodiment set

forth in the appellant's written description Ehlscheid does teach a substantially rigid and planar plate. Moreover, Ehlscheid teaches a die having a back side capable of being completely and concurrently supported by a substantially planar surface of a portable die cutting apparatus as pressure is simultaneously applied to the cutting edge. In addition, Ehlscheid does teach a die having dimensions for compact and portable storage.

The rejections of claims 71-74 under 35 U.S.C. 103(a) as being unpatentable over Gaspari or Ehlscheid.

Appellants argue that neither Gaspari nor Ehlscheid teaches or suggests the dimensions recited and one of ordinary skill in the art would not have been motivated to develop dies with the dimensions recited. Appellants further argue that the Declaration of Eric J. Ruff identifies several reasons that dies having the dimensions recited would have been non-obvious.

The examiner respectfully disagrees. It is the examiner's position that one having ordinary skill in the art would have been motivated to make the plate having different peripheral dimensions (e.g., 2" x 2") in order to accommodate sizes of indicia desired or sizes and shapes of cutouts desired. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Furthermore, there is no statement in the above-mentioned Declaration regarding a need of specific dimensions set forth in claims 71-74. It merely states that 80 of dies weigh about a pound. It is the examiner's

opinion that 80 of Ehlscheid's die could weigh less than a pound depending on peripheral dimensions.

Comments from conferees.

Whiles the examiner has applied a die against the claims, it is to be noted that claim 48 is so broad that it reads on other commonly known items such as, credit cards, bottle caps, or sole of a shoe. While not originally intended as part of the appeal, conferees suggested that this observation be brought to the attention of the Board.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Stephen Choi/

Stephen Choi
Primary Examiner, AU 3724

Conferees:

/Allan N. Shoap/

Allan N. Shoap, SPRE

/Boyer D. Ashley/

Boyer D. Ashley, SPE